

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

37837-75702

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on \_\_\_\_\_

Signature \_\_\_\_\_

Typed or printed name \_\_\_\_\_

Application Number

09/903001

Filed

2001-07-11

First Named Inventor

Mark Pratt

Art Unit

3687

Examiner

Frenel, Vanel

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

/SDB/

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

Signature

Shawn D. Bauer

Typed or printed name

☒ attorney or agent of record.  
Registration number 41603

317-231-7313

Telephone number

☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

October 1, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below.

☒ \*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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## ***IN THE UNITED STATES PATENT AND TRADEMARK OFFICE***

<i>Customer No.</i>	23643	}
		}
<i>Group:</i>	3687	}
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<i>Confirmation No.:</i>	1918	}
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<i>Application No.:</i>	09/903,001	}
		}
<i>Invention:</i>	<b>AUDIO/VIDEO AUTOMATED PAYMENT FACILITY</b>	}
		}
<i>Inventor:</i>	Mark Pratt et al.	}
		}
<i>Filed:</i>	July 11, 2001	}
		}
<i>Attorney Docket:</i>	37837-75702	}
		}
<i>Examiner:</i>	Frenel, Vanel	}

**ELECTRONICALLY  
SUBMITTED:**

**October 1, 2009**

### **REASONS IN SUPPORT OF REQUEST FOR PRE-APPEAL CONFERENCE**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Sir:

In the Final Office Action dated April 3, 2009 (hereafter “the Final Office Action”) each of claims 1-13 was rejected under Section 103 based on U.S. Patent Application Publication No. 2002/0032601 issued to Admasu et al (hereinafter “Admasu”) in view of U.S. Patent Application Publication No. 2001/0001321 issued to Resnick et al (hereinafter “Resnick”). These rejections are improper because, amongst other things, the combination fails to include all of the limitations of the claimed invention and appears to be based entirely on hindsight.

## APPLICANTS' INVENTION

Generally, Applicants' invention is directed to a combination or subcombination of an automated payment system for a parking facility having, amongst other things, an exit gate to control egress from the parking facility; a payment terminal for assessing and receiving a payment, and ***means for providing two-way video and audio communication with a monitoring facility remote from said payment terminal.*** (emphasis noted from claim 1, with a similar recitation appearing in each of the other independent claims)

## ADMASU

Admasu is directed to a wireless-based payment system in which a customer uses his or her cell phone to pay for parking at either a parking meter or a gated lot. The Final Office Action indicates that all of the limitations of Applicants' independent claims, except for the two-way audio/video connection, are taught by Admasu. Applicants note that the Final Office Action picks and chooses from the discussion of prior art devices in the background and two distinct embodiments of Admasu to arrive at such a conclusion. Applicants will hold further discussion relating to this argument in abeyance for purposes of brevity.

## RESNICK

Resnick is directed to a system by which end-users can "recharge" a prepaid cellular account by the use of point-of-sale (POS) terminals found on the existing credit card network (e.g., VisaNet). The Final Office Action cites to paragraph [0034] for a teaching of "two-way audio and video interaction between a customer at the payment terminal and a live attendant at the monitoring facility." With all respect, this is a complete and utter misreading of the Resnik. In fact, a careful reading of this paragraph, along with supporting paragraphs [0028]-[0030] (and associated FIG. 3), make it clear that the interaction is nothing more than a voice menu system in which the customer can "hit 0" to be connected to a customer service representative (CSR) who can log onto a web browser to look up information to answer any questions the user may have. It is the same system we all use in our daily lives when we call tech support or customer service – we can either get the information we need from the voice menu or "hit 0" to talk to a rep who looks up our account and answers questions. There is no two-way video between the caller and rep. It simply doesn't exist.

## THE COMBINATION FAILS TO ARRIVE AT THE INVENTION

As noted above, the Final Office Action concedes that Admasu does not disclose a two-way audio/video connection with a monitoring facility. As also described above, despite the Final Office Action's reliance on Resnik for such a teaching, it, too, fails to disclose a two-way audio/video connection of any type. As such, for this reason alone, the rejection is flawed and must be withdrawn.

## THERE IS NO REASONED ANALYSIS IN SUPPORT OF THE COMBINATION

Any legally-sufficient rejection based on obviousness must include a reasoned analysis as to why the references are combinable. The Final Office Action provides absolutely no such analysis, but instead merely copies and pastes paragraph [0006] from Resnik's summary and uses it as a substitute for such an analysis. This passage of Resnik simply espouses the features of its invention, all of which appear to be either irrelevant to a parking system or redundant with other features already included in Admasu. Because there is literally nothing in the Final Office Action to explain why one skilled in the art would modify Admasu to include such irrelevant, redundant features, one can only conclude that the combination is based entirely on hindsight.

## REQUEST OF THE CONFERENCE MEMBERS

This has been the most unusual of prosecutions. Applicants have made every effort to advance prosecution of this application over the last eight years. To wit, this application was filed on July 11, 2001. **A first Office Action** was mailed on September 9, 2004 by Examiner Chilcot rejecting all of the claims under Section 103 over Hall and Kaehler. A response to that Office Action was filed pointing out, amongst other things, the combination lacked a teaching of a two-way audio/video connection. **A second Office Action** was mailed by Examiner Chilcot on May 18, 2005 summarily dismissing all of Applicants' arguments and making the rejection final. Applicants filed a Notice of Appeal, and in the associated Appeal Brief reiterated their previous arguments.

In response to that Appeal Brief, **a third Office Action** was issued by newly-assigned Examiner Zeender who withdrew the previous rejections and issued a new rejection of all of the claims under Section 103 over Mehdipour and Kaehler. *No supervisory approval was obtained by Examiner Zeender when reopening prosecution.* Because the new rejection was entirely cumulative of the previous rejections, Applicants again filed a Notice of Appeal, and in the associated Appeal Brief reiterated their previous arguments that, amongst other things, the new combination did not include a two-way audio/video connection. In response to the second Appeal Brief, **a fourth Office Action** was issued by newly-assigned Examiner Vanel who withdrew the previous rejections and issued a new

rejection of all of the claims under Section 103 over Townzen and Parsadayan. *No supervisory approval was obtained by Examiner Vanel when reopening prosecution.* Applicants filed a response pointing out that Townzen was not prior art to the present application.

The Applicants were to be rejected yet again when Examiner Vanel mailed a **fifth Office Action** on March 19, 2008 withdrawing the previous rejections and issuing a new rejection of all of the claims under Section 103 over Admasu and Martinez. *No supervisory approval was obtained by Examiner Vanel when sending this Office Action.* A response to this Office Action was filed pointing out that the combination lacked a teaching of a two-way audio/video connection, and requesting supervisory approval for this and future office actions. Applicants' request was ignored when Examiner Vanel mailed a **sixth Office Action** on January 7, 2009, *once again without supervisory approval*, withdrawing the previous rejections and issuing a new rejection of all of the claims under Section 103 over Admasu and Fulcher.

On January 13, 2009, Applicants' attorney, Richard Lazarus, had an interview with Examiner Vanel's supervisor, Matthew S. Gart. As noted in the Interview Summary dated January 16, 2009, the limitations relating to a two-way audio/video connection were discussed. It was decided that minor amendments relating to "live video interaction" would be added and "[w]hen received the newly amended claim will be evaluated in view of the references of record."

Imagine the surprise of the Applicants when, on April 3, 2009, Examiner Vanel mailed a **seventh Office Action** withdrawing the previous rejections and issuing a new, final rejection of all of the claims under Section 103 over Admasu and Resnik. *Once again, despite Applicants' request to do so, no supervisory approval was obtained by Examiner Vanel prior to sending this Office Action. And, despite being the very reason for abandonment of most of the previous rejections, this seventh Office Action is again based on a combination that lacks a teaching of a two-way audio/video connection.*

This application has received seven office actions, most of which are nothing more than cumulative of the other ones. They are based on combinations constructed largely, if not entirely from hindsight, and not only consistently fail to include all of the limitations of the claims, but fail to include the same limitation each time. Applicants are now being forced to appeal for the third time. *Because of this, the Pre-Appeal Conference is respectfully urged to allow this application.* Both equity and the notion of compact prosecution require this result. With all respect, numerous different examiners have looked at this application a combined seven times and have not once produced a legally-sufficient grounds of rejection. Keep in mind that only one time has the Office even maintained its rejection from a previous office action (the second office action maintained the rejections of the first office action, with such rejections subsequently being abandoned in the third office when confronted with Applicants's first

appeal brief) – i.e., it has been an exercise in constant redirection. It is hard to imagine that seven office actions were required to examine these conceptually straight-forward claims, and nearly impossible to imagine that further examination by the examiner is required.

*As such, if the Pre-Appeal Conference is not willing to allow this application, Applicants respectfully request the simple courtesy of allowing this appeal to advance to the Board of Appeals.* In particular, Applicants respectfully ask the Supervisory Examiners to instruct Examiner Vanel to forego the Office's increasingly-used practice of issuing final office actions and then re-opening prosecution once an applicant has endured the effort and expense to file an appeal brief. Applicants have already been forced to endure the delay and expense associated with this practice twice before. In light of Examiner Vanel's four rejections of the claims based on what are largely cumulative references and reasonings, such a result appears both warranted and in the best interest of all parties. We have simply reached an impasse that will not be broken by the further ping-ponging of office actions and responses.

#### CONCLUSION

In conclusion, the Section 103 rejections of the claims are flawed because, amongst other things, they fail to arrive at the invention and are based entirely on hindsight. Applicants understand that the pre-appeal review process has a limited scope. Applicants therefore hold in abeyance those arguments that are outside the scope of the pre-appeal review process without prejudice or admission.

It is respectfully requested that, if necessary to effect a timely response, this paper be considered as a Petition for an Extension of Time sufficient to effect a timely response. The Commissioner is hereby authorized to charge the fee for such Petition and any shortage of fees, and credit any overpayment of fees, to the Account of Barnes & Thornburg, Deposit Account No. 10-0435 with reference to file 37837-75702.

Respectfully submitted,

BARNES & THORNBURG LLP



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October 1, 2009  
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INDS02 SDB 1072580v1